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| 09/913,924 | 08/20/2001 | Jeffery M. Zaleski | 212691 | 5503 |

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LEYDIG VOIT & MAYER, LTD
TWO PRUDENTIAL PLAZA, SUITE 4900
180 NORTH STETSON AVENUE
CHICAGO, IL 60601-6780

EXAMINER

FORD, JOHN M

| | |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1624

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/013424

Applicant(s)

Zalcor

Examiner

J M Ford

Group Art Unit

162

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 11-10-03

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☐ Claim(s) 12, 5--9, 14--37, 39 and 40 is/are pending in the application.

Of the above claim(s) 28--34 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, 5--9, 14--27, and 35--37 is/are rejected.

☒ Claim(s) 39 and 40 is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

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Applicants' response of Nov. 10, 2003, is noted.

Claim 1 is rejected under 35 U.S.C. 112, 2nd paragraph. The terms "heterocycle or macrocycle cannot be allowed in R1 and R2, as they are outside the invention elected, and they do not meet 35 U.S.C. 112, 1st or 2nd paragraph.

"M is at least one additional ligand other than a ligand of the formula" is open to the inclusion of unknowns, and could not be allowed. It is suggested that claims 1 and 14 be combined.

The polymer of the last few lines of claimed could not be allowed, as it is beyond the monoester elected here, and is an extremely burdensome request.

Look at claim 26 and 28 B is sulfur. Look at claim 37. B in S. ~~Why~~ is it removed from claim 1?

The heterocycle and macrocycle language of claim 19 is outside the invention elected or searchable terms.

Claim 28 cannot be seen to be includable here. There is too much burden in the number and diversity of the claims.

Claims 28—34 are considered outside the invention elected. Claims 28—34 are held to be non-elected subject matter. The claims are getting too far from the species elected, and ^{would require} too much searching burden, and ^{have} too many unknowns.

We need to construct a genus claim that can be searched; that is reflective of the species elected; ~~that~~ that is within the limits of the species elected.

The CCPA in *In re Herrick et al.* and *In re Joyce* (both at 115 USPQ 412) held that an election of species requirement was, in fact, a restriction requirement.

This is a 371 application. Content in a 371 application is governed by 37 CFR 1.475. One invention, ~~In~~ the instance of multiple products, as in the original claim 1, a searchable genus need be arrived at, the terms macrocyclic, heterocyclic and polymer are outside the invention elected by the species. Macrocyclic, heterocyclic and polymer are too large and all encompassing to be searched and dealt with here.

Claim 1 need be re-written to a searchable genus reflective of the limits of burden and the species elected.

Claims 2 and 5—7 are rejected as being dependent on a rejected claim, as it could not be allowed in dependent form, and would contain rejected portions of claim 1.

Claim 8 is rejected under 35 U.S.C. 112, 2nd paragraph, as it does not say what the nitrogen-containing group is.

Claims 9 and 14 are rejected under 35 U.S.C. 112 as “at least” is open to the inclusion of unknowns.

Claims 15—19 are rejected as being dependent on a rejected claim.

In claims 16, 18 and 19, “at least” is open.

In claim 18, it only says M is other than: --it does not say what it is.

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In claim 19, it only says that the ligand includes (among others) a substituent--it does not say what the ligand is.

In claims 20 and 21, heterocyclic broadly cannot be dealt with. It is too open, and outside the invention elected.

In claim 22, it does not say how the bi-pyridyl is bonded in.

Claim 23 is a partial structure, at least is open.

In claim 24 – bicyclic is too vague.

In claim 25, what is the aryl, and how is it bonded into the rest of the claimed molecule.

In claims 23 and 26, “at least” is open. “includes” is open in claim 24. In claim 26, how is the ligand bonded into the rest of the claimed molecule? Where is Q2 in claim 1?

In claim 27, “at least” and “includes” are open to the inclusion of unknowns.

It would appear B and B1 in claim 1, should include sulfur.

Claim 35 should be written dependent on claim 1.

Claim 36 is not understood. How does that relate to claim 1?

Claim 37 seems to reflect the need, for B and B1 to be sulfur in claim 1.


Claims 39-40 are objected to as being dependent on a rejected claim.

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The restriction requirement is not made Final, as we are still negotiating what the allowed claims will look like. Nothing is made Final.

J. M. Ford:jmr

December 24, 2003


JOHN M. FORD
PRIMARY EXAMINER
Group A & Unit 1624